REMARKS

Claims 1-31 and 34 are pending.

Claims 1-6, 25-29 and 34 were examined and rejected.

Claims 1 and 2 are amended. Support for the amendment is found in the specification as originally filed, particularly page 8, lines 22-27.

No new matter is added.

Reconsideration of this application is respectfully requested.

Claim Rejections 35 U.S.C. § 112, first paragraph (new matter)

Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as containing new matter. The Applicants respectfully traverse this rejection.

The written description requirement of 35 U.S.C. § 112, first paragraph, involves the question of whether the subject matter of a claim conforms to the disclosure of an application as filed. According to the MPEP, an objective standard for determining compliance with the written description requirement is, "does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed?"[1] The subject matter of the claim need not be described literally (i.e. using the same terms or *in haec verba*) in order for the disclosure to satisfy the written description requirement. Likewise, MPEP states that newly added claim limitations may be supported by disclosure that is express, implicit, or inherent.[2]

In attempting to establish this rejection the Examiner argues that oligonucleotides that bind to CpG islands under stringent hybridization conditions are not described in the specification as filed.

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[1] See MPEP § 2163.02, citing *In re Gosteli* 872 F.2d 1008, 1012 (Fed. Cir. 1989).

[2] MPEP § 2163: "The written description requirement prevents an applicant from claiming subject matter that was not adequately described in the specification as filed. New or amended claims, which introduce elements or limitations, which are not supported by the as-filed disclosure, violate the written description requirement...While there is no *in haec verba* requirement, ***newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure***. (emphasis added)

The Applicants submit, however, that oligonucleotides that bind to CpG islands under stringent hybridization conditions are described throughout the specification, for example on page 15, lines 5-6 and page 15, lines 16-27, among other places.

In view of the foregoing discussion, the Applicants submit that the current claims recite subject matter that is no broader than as described in the specification as originally filed. As such, the Applicants believe that the written description requirement of 35 U.S.C. § 112, first paragraph, has been satisfied, and no new matter has been added.

Withdrawal of this rejection is requested.

Claim Rejections 35 U.S.C. § 112, second paragraph

Claims 1-6 and 25-29 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In attempting to establish this rejection the Examiner argues that the term "stringent hybridization conditions" is indefinite.

Without any intention to acquiesce to the correctness of this rejection and solely to expedite prosecution, claims 1 and 2 are amended to recite "stringent assay conditions", a clear definition for which is set forth on page 8 of the specification.

The Applicants submit that this rejection is moot and may be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claim 1-6 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huang (6,605,432) in view of Katyavin (5,912,340).

According to the MPEP § 706.02 (j), to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As best understood by the Applicants, the Examiner has attempted to establish this rejection by arguing that Huang's CpG polynucleotide-containing arrays, in combination with Katyavin's UNA oligonucleotides, renders the instant claims obvious. In making this rejection, the Examiner argues that the instant claims are obvious because Huang would get better results if his probes were be modified to contain UNA nucleotides.

However, Huang states that his method is highly accurate, sensitive, and efficient (see, e.g., the first paragraphs of the Summary of the Invention and of the Detailed Description, among other places). Huang's makes no mention of low signal strength, probe secondary structure, or of any other limitation that could be cured by use of a UNA nucleotide. Thus, Huang provides no motivation to modify his probes to contain a UNA nucleotide. Without the roadmap provided by the instant patent application, the Applicants submit that this motivation does not exist.

Further, the Applicants submit that according to Huang's disclosure, Huang's probes are very long and PCR generated, and thus not synthesizable using UNA nucleotides. Huang does not discuss the use of oligonucleotide probes, nor synthetic probes. Thus, it is not possible to alter Huang's probes in the manner proposed by the Examiner.

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is respectfully requested.

Claim 25-29 and 34 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huang (6,605,432) in view of Katyavin (5,912,340) and Ahern (The Scientist, 1995).

As noted above, Huang cannot be combined with Katyavin to render the instant claims obvious because: a) one of skill in the art would have no motivation to make the modification proposed by the Examiner and b) it is not possible to modify Huang's probes in the manner proposed.

Ahern is provide a kit. Ahern's kit fails to meet the deficiencies of Huang and Katyavin and, as such, this rejection should be withdrawn.

Withdrawal of this rejection is requested.

Claim 1-6 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huang (6,605,432) in view of Sampson (20050032055).

The Applicants submit that the subject matter of the cited Sampson patent application and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Agilent. Accordingly, Sampson cannot preclude the patentability of the rejected claims, and this rejection may be withdrawn.

Support for this assertion is set forth below:

35 U.S.C. 103 (a) states that a patent may not be obtained if the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made[3]. 35 U.S.C. 103 (c), however, states that subject matter developed by another person shall not preclude patentability under 103(a) where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.[4]

According to 35 USC § 103(c), therefore, the Sampson patent cannot preclude the patentability of the rejected claims if the Sampson patent and the instant application were assigned to the same person or subject to an obligation of assignment to the same person, at the time the instant invention was made.

The invention claimed in the instant patent application was owned by Agilent Technologies, Inc. ("Agilent") or subject to an obligation of assignment to Agilent at the time the instant invention was made.

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[3] 35 U.S.C. 103(a) : A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[4] 35 U.S.C. 103(c): Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The Sampson patent application was owned by Agilent or subject to an obligation of assignment to Agilent at the time the instant invention was made.

Thus, the Sampson patent application and the claimed invention were, at the time the invention was made, assigned or under obligation of assignment to Agilent. Accordingly, Sampson cannot preclude patentability of the instant claims under 103(a).

Withdrawal of this rejection is requested.

Claim 25-29 and 34 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huang (6,605,432) in view of Sampson (20050032055) and Ahern.

As noted above, Sampson cannot preclude the patentability of the instant claims.

Withdrawal of this rejection is requested.

CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone James Keddie at (650) 833-7723.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10031482-1.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: May 7, 2007

By: _____
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